



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
09/891,913	06/26/2001	Tara Chand Singhal	11195.33	1401				
7590 Tara Chand Singhal P.O. Box 5075 Torrence, CA 90510		11/01/2007	<table border="1"><tr><td>EXAMINER</td></tr><tr><td>MONFELDT, SARAH M</td></tr></table>		EXAMINER	MONFELDT, SARAH M		
EXAMINER								
MONFELDT, SARAH M								
			<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3692</td><td></td></tr></table>	ART UNIT	PAPER NUMBER	3692		
ART UNIT	PAPER NUMBER							
3692								
			<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>11/01/2007</td><td>PAPER</td></tr></table>	MAIL DATE	DELIVERY MODE	11/01/2007	PAPER	
MAIL DATE	DELIVERY MODE							
11/01/2007	PAPER							

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/891,913

Applicant(s)

SINGHAL, TARA CHAND

Examiner

Sarah M. Monfeldt

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS; WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-60, 71 and 77-80 is/are pending in the application.
- 4a) Of the above claim(s) 67 and 86-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-60, 71 and 77-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 67 and 86-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION
Status of Claims

1. This action is in reply to the Amendment/Response filed on 9 August 2007.
2. Claims 52, 56, 67, 71, 77 have been amended.
3. Claims 86-93 have been added.
4. Claims 61-66, 68-70, 74-76, 84-85 have been canceled.
5. Claims 52-60, 67, 71, 77-80, 86-93 are currently pending and have been examined.
6. Claims 67 and 86-93 are withdrawn from further consideration as being drawn to inventions that are independent or distinct from the invention originally claimed for at least the below reasons.

Election/Restrictions

7. Newly submitted claims 67 and 86-93 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
 - a. Group I: Claims 52-60, 71, 77-80 drawn to payment transactions, classified in class 705, subclass 40;
 - b. Claim 67, drawn to a payment system that protects customer identity data from theft in merchant systems, includes [e]ncrypted data from a merchant point of sale, etc., classified in class 705, subclass 64;
 - c. Claims 86-87, drawn to a system to identify security in use of bankcards, classified in class 705, subclass 72;
 - d. Claims 88-90, drawn to a merchant point of sale terminal that protects customer identity data from potential theft, classified in class 705, subclass 16; and
 - e. Claims 91-93, drawn to a method of secure data storage of a bankcard number, classified in class 707, subclass 100.
8. The inventions are distinct, each from the other because Inventions 1-2 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention has separate utility (See MPEP 806.05d).
9. Because these inventions are distinct for being separately usable, as shown above, examining the inventions together would require searching for a reference teaching the unique element(s) of each invention that are not found in the remaining inventions. This would be quite burdensome, requiring multiple searches, and thus the restriction for examination purposes, as indicated, is proper.

Art Unit: 3692

10. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 67 and 86-93 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

11. Claims 52-60, 71, 77-80 are objected to because of the following informalities: The dependent claims recite "The claim as in". The dependent claims should track the independent claim and should recite for example "the payment card of claim" with respect to claims 53-60 and claims 78-80 should recite "the method of claim". Appropriate correction is required.

Claim Rejections - 35 USC § 112, First Paragraph

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
13. Claims 52-60, 71, 77-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example:
- a. Claim 52 recites "without a computer processing ability as in a micro processor", "permanently identifies" these recitations do not find antecedent basis in the specification as filed.
 - b. Claim 55 recites "pre-stored his/her bankcard data", this recitation does not find antecedent basis in the specification as filed.
 - c. Claim 56 recites "physically delivered to the customer", this recitation does not find antecedent basis in the specification as filed.
 - d. Claims 71 and 77 recite "pre-stored", this recitation does not find antecedent basis in the specification as filed.
 - e. Claim 77 recites "at least two", this recitation does not find antecedent basis in the claims as filed.

Art Unit: 3692

- f. The remainder of the claims contain similar issues, Applicant is required to review the claims to ensure no new matter has been added. Also, in view of the above, appropriate correction is required.

Claim Rejections - 35 USC § 112, Second Paragraph

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
15. Claims 52-60, 71, 77-80 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
16. Claim 58 recites the limitation "the bankcard processor" in line 4. There is insufficient antecedent basis for this limitation in the claim. It appears that this recitation is referring to (a bankcard authorization network), it is suggest that Applicant pick one term and use it consistently throughout the claims. Appropriate correction is required.
17. Claim 60 recites "the payment transaction" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
20. Claims 52-55, 57-60, 71, 77-80 rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (US 5692044) in view of Brody (US 2001/0029485) and Maes (WO 99/08238).

Art Unit: 3692

Claim 52 –

As per claim 52, Wong discloses a payment card for conducting a payment transaction between a customer and a merchant that protects the customer identity data by not having customer identity data on the card itself and not transferring such data to a merchant during a payment transaction having the limitations of:

- *a substrate; (see at least Fig. 1, col. 12, ll. 20-30)*
- *an alias, the alias name being selected by the customer; (see at least col. 12, ll. 47-49)*
- *a customer-identifier encoded on an encoding medium on the substrate. (see at least col. 12, ll. 53-58)*

Wong does not explicitly disclose the following:

- *an alias name printed on the substrate;*

Wong however, discloses that the name is displayed on an LCD screen on the card (see at least col. 12, ll. 47-49). Furthermore, Wong discloses that it was old and well known in the art to use embossing techniques to print names on a payment card (see at least col. 1, ll. 14-18). Therefore, because these two technologies were art-recognized equivalents at the time the invention was made, one of ordinary skill in art would have found it obvious to substitute LCD displaying for printing of a name on a payment card.

Wong does not explicitly disclose the following:

- *[p]ermanently identifies the customer to a payment system that is without customer identity of name and bankcard number[r], [w]hereby the payment card does not have customer identity data and thus does not transfer such data to a merchant during a payment transaction.*

Brody creates dynamic mappings of the card number to account numbers and utilizes an anonymous transaction server (third party) that identifies anonymous card attributes, maps them to the customers true credit card and forwards this information to the bank which then further forwards it to the merchant (see at least paragraph [0045] and Fig. 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the teachings of Brody to the disclosure of Wong to that customer and merchants are protected from the potential theft of credit card information during transactions.

Wong does not explicitly disclose the following:

- *a substrate without a computer processing ability as in a microprocessor;*

Art Unit: 3692

Maes teaches a *substrate without a computer processing ability as in a microprocessor* (see at least pg. 5, ll. 12-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the card of Brody to include either a magnetic card or a smart card as taught by Maes. One of ordinary skill in the art at the time of the invention would have been motivated to expand the payment card for making payment transactions of Wong in this way since magnetic cards and smart cards these were art-recognized equivalents at the time the invention was made and the universal card of Maes also eliminates the burden of having to carry a multitude of financial cards and/or credit cards that a user may frequently utilize (see at least pg. 5, ll. 1-16 of Maes).

Claim 53 –

As per claim 53, Wong in view of Brody and Maes teach the payment card of claim 52 as described above.

- *the encoding medium is a magnetic strip. (see at least col. 12, ll. 53-54 of Wong)*

Claim 54 –

As per claim 54, Wong in view of Brody and Maes teach the payment card of claim 52 as described above.

- *the customer-identifier is self created by the customer. (see at least col. 7, ll. 16-19 of Wong)*

Claim 55 –

As per claim 55, Wong in view of Brody and Maes teach the payment card of claim 52 as described above.

- *the customer-identifier identifies the customer to a payment system, wherein the customer has an account and has pre-stored his/her bankcard data identifying each bankcard with a card specific personal identification number (CPIN). (see at least col. 5, ll. 47-65; col. 11, ll. 47-65 of Wong)*

Claim 57 –

As per claim 57, Wong in view of Brody and Maes teach the payment card of claim 55 as described above.

- *the customer swipes the card at a merchant point-of-sale (POS) terminal, enters the CPIN, to effect payment to the merchant from a bankcard identified by the CPIN. (see at least col. 11, l. 34 – col. 12, l. 3 of Wong)*

Art Unit: 3692

Claim 58 –

As per claim 58, Wong in view of Brody and Maes teach the payment card of claim 57 as described above.

- *the POS terminal transfers the customer-identifier, the CPIN, a merchant identifier, and a payment amount to a gateway to a bankcard authorization network (bankcard processor), wherein the bankcard processor interfaces with the payment system using the customer-identifier and the CPIN. (see at least col. 11, l. 34 – col. 12, l. 3 of Wong)*

Claim 59 –

As per claim 59, Wong in view of Brody and Maes teach the payment card of claim 58 as described above.

- *the payment system uses the customer-identifier to identify customer in the payment system and with the CPIN retrieves specific bankcard data selected by the customer and sends it to the bankcard processor. (see at least col. 5, ll. 47-65 of Wong)*

Claim 60 –

As per claim 60, Wong in view of Brody and Maes teach the payment card of claim 59 as described above.

- *the bankcard processor processes the payment transaction between the customer and the merchant, and sends payment approval data to the merchant POS terminal. (see at least col. 12, l. 47 – col. 12, l. 3 of Wong)*

Claim 71 –

As per claim 71, Wong discloses a payment transaction method between a customer and a merchant equipped with a point of sale (POS) terminal for accepting payments having the limitations of:

- *swiping a payment card at the POS terminal by a customer with the payment card encoded with a customer-identifier; (see at least col. 12, ll. 53-58)*
- *entering a card specific PIN for selecting a specific bankcard for this payment transaction from at least two bankcards of the customer that are pre-stored in a payment system; (see at least col. 4, ll. 53-55, col., 5, ll. 47-65; “enables accessing a selected one of a plurality of different accounts”)*
- *receiving payment transaction data from the POS terminal by a bankcard processor, interfacing with a payment system with the customer-identifier and the CPIN and retrieving the bankcard data intended for the payment transaction; (see at least col. 5, ll. 47-65)*

Art Unit: 3692

- *processing payment transaction by the bankcard processor and sending payment approval data to the merchant POS terminal, thereby the method enabling the customer to use one private payment card in lieu of other bankcards. (see at least col. 5, ll. 56-65)*

Wong does not explicitly disclose the following:

- *[w]ithout customer identity of name and bankcard number[.]*

Brody discloses systems and methods for a customer identifier that are anonymous and without the name and bankcard number. Brody creates dynamic mappings of the card number to account numbers and utilizes an anonymous transaction server (third party/payment system that prestores customer identifier and plurality of bankcards identified) that identifies anonymous card attributes, maps them to the customer true credit card and forwards this information to the bank which then further forwards it to the merchant (see at least paragraph [0045], and Fig. 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the teachings of Brody to the disclosure of Wong so that customers and merchants are protected from the potential theft of credit card information during transactions.

Claim 77 –

As per claim 77, Wong discloses a method of selecting any one of at least two of bankcards of a customer at a merchant point of sale for a payment to a merchant having the limitations of:

- *entering of a customer identifier, and a bankcard specific personal identification number (CPIN) in the point of sale interface; (see at least col. 4, ll. 53-55)*
- *sending the identifier and the CPIN to a card processor; (see at least col. 5, ll. 61-65)*
- *interfacing by the card processor with a payment system, wherein the customer having at least two pre-stored customer bankcard data, each bankcard identified with the CPIN; (see at least col. 5, ll. 47-65)*
- *returning to the card processor the bankcard data corresponding to the customer identifier and the CPIN from the payment system. (see at least col. 5, ll. 56-65)*

Wong does not explicitly disclose the following:

- *[w]ithout customer identity of name and bankcard number[.]*

Brody discloses systems and methods for a customer identifier that are anonymous and without the name and bankcard number. Brody creates dynamic mappings of the card number to account numbers and utilizes an anonymous transaction server (third party/payment system that prestores customer identifier

Art Unit: 3692

and plurality of bankcards identified) that identifies anonymous card attributes, maps them to the customer true credit card and forwards this information to the bank which then further forwards it to the merchant (see at least paragraph [0045], and Fig. 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the teachings of Brody to the disclosure of Wong so that customers and merchants are protected from the potential theft of credit card information during transactions.

Claim 78 –

The claim as in 77

- *identifying a particular bankcard of the customer and verifying the customer by the CPIN. (see at least col. 5, ll. 61-65 of Wong)*

Claim 79 –

The claim as in 77

- *processing the payment transaction with the bankcard data by the card processor. (see at least col. 5, ll. 61-65 of Wong)*

Claim 80 –

The claim as in 78

- *having access to the payment system by the customer; (see at least col., 5, ll. 47-65; “enables accessing a selected on of a plurality of different accounts” of Wong)*
- *entering the bankcard data and self-selecting a CPIN for each bankcard of the customer. (see at least col., 5, ll. 47-65; “enables accessing a selected on of a plurality of different accounts” of Wong)*

21. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (US 5,692,044) in view of Brody (US 2001/0029485) and Maes (WO 99/08238), as applied to claims 52-55, 57-60, 71, 77-80 above, further in view of Weiss (5,657,388).

Claim 56 –

As per claim 53, Wong in view of Brody and Maes teach the payment card of claim 52 as described above. Wong in view of Brody and Maes do not explicitly disclose the following:

- *an algorithm used to encrypt the customer-identifier, the encrypted customer-identifier appended with a reference to the algorithm is encoded on the payment card as an encrypted customer-identifier, and the card is physically delivered to the customer.*

Art Unit: 3692

Weiss teaches *an algorithm used to encrypt the customer-identifier, the encrypted customer-identifier appended with a reference to the algorithm is encoded on the payment card as an encrypted customer-identifier, and the card is physically delivered to the customer* (see at least col. 2, ll. 43-46, col. 4, ll. 36, Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the payment card of Wong in view of Brody and Maes to include an algorithm as taught by Weiss. One of ordinary skill in the art at the time of the invention would have been motivated to expand the payment card of Wong in view of Brody and Maes in this way since Maes recognized that the Maes Universal Card system could be used to store and access personal information such as medical, financial information and other confidential information, thus Maes recognized confidential information such as financial and medical (Weiss) as art-recognized equivalents at the time the invention was made (see at least pg. 15, ll. 14-18 of Maes).

Double Patenting

22. Claims 52-55, 57-60, 71, 77-80 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-29 and 32-35 of copending Application No. 10/046834. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to payment systems for private and secure transactions, payment cards/systems that protects the customer identity data.
23. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah M. Monfeldt whose telephone number is (571)270-1833. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm (EST) ALT Fridays off.

Art Unit: 3692

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sarah M. Monfeldt
Patent Examiner, AU 3692
571-270-1833



Kambiz Abdi
AU 3692, SPE

**KAMBIZ ABDI
SUPERVISORY PATENT EXAMINER**